UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/657,039	09/07/2000	Christopher Lee Tobey	JP920000169US1	1586

30449 7590 06/07/2004

SCHMEISER, OLSEN + WATTS
SUITE 201
3 LEAR JET
LATHAM, NY 12033

EXAMINER	
BLECK, CAROLYN M	

ART UNIT	PAPER NUMBER
3626	

DATE MAILED: 06/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/657,039	TOBEY, CHRISTOPHER LEE	
	Examiner	Art Unit	
	Carolyn M Bleck	3626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *07 September 2000*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-25* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-25* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Notice to Applicant

1. This communication is in response to the application filed 7 September 2000. Claims 1-25 are pending.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 1-12 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

(1) whether the invention is within the technological arts; and

(2) whether the invention produces a useful, concrete, and tangible result.

(A) For a claimed invention to the statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example), and therefore are found to be non-statutory

subject matter. For a process claim to pass muster, the process must somehow apply, involve, use, or advance the technological arts.

In the present case, claim 1 only recites an abstract idea. The recited steps of merely receiving a new asset at a central site, assigning a unique identifier to each said asset, recording the location of said asset with respect to said central site in a database, and on each movement of said asset, recording exit of the asset from the current site in said database, recording the intended destination site in said database, and verifying entry of the asset at the destination site, being the new current location, in said database, does not apply, involve, use, or advance the technological arts since all of the recited steps can be performed in the mind of the user or by use of a pencil and paper. These steps only constitute an idea of how to track physical assets.

Additionally, for a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result. In the present case, the claimed invention records the movements of assets (i.e., repeatable) using the location of the asset defined by an identifier (i.e., useful and tangible).

Although the recited process produces a useful, concrete, and tangible result, since the claimed invention as a whole, is not within the technological arts as explained above, claim 1 is deemed to be directed to non-statutory subject matter.

(B) Similar analysis can be applied to independent claim 8. Therefore claim 8 is rejected for the same reasons as claim 1.

(C) The same analysis can be applied to dependent claims 1-7 and 9-12. Therefore those claims are rejected for the same reasons as claim 1 and 8.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 1-2, 6-7, 13-14, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sims et al. (5,434,775) in view of Bates (6,057,779).

(A) As per claim 1, Sims discloses a method for tracking the locations of a plurality of deices using a network of communication links comprising (Abstract):

(a) initially storing a new device at a materials management area (col. 15 lines 40-55) (reads on "receiving a new asset at a central site");

(b) entering information about the new device (e.g., name, manufacturer, serial number, property number, etc.) through a computer interface and providing each of said new devices with a tag that identifies said device with respect to other said devices, wherein the tag comprises a tag address to identify the particular device (Fig. 8-9, col. 5 line 55 to col. 6 line 23, col. 15 lines 40-55, col. 22 lines 45-50, col. 23 lines 4-12) (reads on " assigning a unique identifier to each said asset");

(c) storing information that relates each one of the plurality of devices to a determined location with respect to the communication links, such as those associated with materials management area and data management computer, in a database (Fig. 1, col. 22 lines 38-44, col. 24 lines 12-15) (reads on "recording the location of said asset with respect to said central site in a database");

(d) when moving a device, detecting an event such as a disconnection of a tag from a link and reporting and entering the event, i.e., the removal of the device from the communication link in it's current location, into the database (Fig. 7-10, col. 9 line 35 to col. 10 line 53) (reads on "on movement of a said asset, recording exit of the asset from the current location"); and

(e) detecting an event such as a connection of a tag to a link and reporting and entering the event, i.e., the addition of the device to the communication link in it's current location, into the database (Fig. 7-10, col. 9 line 35 to col. 10 line 53).

Sims fails to expressly disclose recording the intended destination site in said database and verifying entry of the asset at the destination site, being the new current location, in said database.

Bates discloses storing in memory a desired geographical location (reads on "recording the intended destination site") and comparing the stored geographical location to a respective determined geographical location to determine whether cargo (reads on "asset") falls within the desired geographical location, wherein the respective determined geographical location is stored in memory (Fig. 7-8, col. 1 lines 35-46, col. 1

line 65 to col. 2 line 7, col. 2 lines 19-40, col. 4 lines 3-63, col. 5 lines 43-55). The teachings of a database are disclosed by Sims, and are discussed above.

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to combine the features of Bates within the method of Sims with the motivation of reducing the risk of theft by preventing unauthorized access to cargo through a system of verifying the location of the cargo (Bates; col. 1 lines 14-32, col. 1 liens 35-46) and in order to rapidly determine where devices are stored, as well as the number of devices that are available for use, to efficiently manage the inventory of devices (Sims; col. 1 lines 10-21).

(B) As per claim 2, Sims discloses equipping a device with an electronic tag that stores data which includes an address (reads on "unique identifier") stored in a memory of each tag that identifies the device with which the tag is associated (col. 1 line 50 to col. 2 line 16, col. 5 line 56 to col. 6 line 23, col. 15 lines 40-55, col. 22 lines 45-50, col. 23 lines 1-13).

(C) As per claim 6, Sims discloses moving a device from a materials management area of a hospital to a room (col. 5 lines 4-28, col. 6 lines 56-63, col. 15 lines 40-55).

(D) As per claim 7, Sims discloses determining the condition of each of device identified by each tag on the device based on detecting the device, wherein the

conditions include ready for use, in need of cleaning, and in need of repair (col. 9 line 35 to col. 10 line 41, col. 22 line 39 to col. 23 line 6).

While Sims and Bates do not expressly disclose "determining whether an asset should be retained, and thus stored for further use, or withdrawn from use", it is respectfully submitted that that Sims disclosure of determining whether a device is in need of repair includes determining whether a device should be retained (i.e., can be fixed) or whether a device should be withdrawn (i.e., cannot be fixed). Thus, at the time the invention was made it would have been obvious to one skilled in the art to modifying the method taught by Sims and Bates collectively to include determining whether an asset should be retained, and thus stored for further use, or withdrawn from use with the motivation of ensuring the devices are in proper condition for use (Sims; col. 1 liens 10-21).

(E) System claims 13-14 repeat the subject matter of method claims 1-2, respectively, as a set of apparatus elements rather than as a series of steps. As the underlying processes of claims 1-2 have been shown to be fully disclosed by the collective teachings of Sims and Bates in the above rejections of claims 1-2, it is readily apparent that the system disclosed collectively by Sims and Bates includes the apparatus to perform these functions. As such, these limitations are rejected for the same reasons given above for method claims 1-2, and incorporated herein.

(F) Claim 24 repeat the subject matter of method claim 1, respectively, as a series of computer program product carried on a storage medium rather than as a series of steps. As the underlying processes of claim 1 have been shown to be fully disclosed by the collective teachings of Sims and Bates in the above rejection of claim 1, it is readily apparent that the system disclosed collectively by Sims and Bates includes a computer program product to perform these functions. As such, these limitations are rejected for the same reasons given above for method claim 1, and incorporated herein.

6. Claims 3-5, 15-17, and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sims et al. (5,434,775) and Bates (6,057,779) as applied to claim 1 above, and further in view of Guthrie et al. (5,289,372).

(A) As per claim 3, the relevant teachings of Sims and Bates, and the motivation for their combination is as discussed in the rejections above, and incorporated herein.

Sims and Bates fail to expressly disclose for each asset, recording configuration information relevant to that asset on said database and on each configuration of a said asset at said central site, updating said configuration information on said database. However, Sims discloses determining the condition of each of device identified by each tag on the device based on detecting the device, wherein the conditions include ready for use, in need of cleaning, and in need of repair, and performing said cleaning and repair in a storeroom area or materials management area (reads on "at central site")

(col. 5 lines 10-28, col. 9 line 35 to col. 10 line 41, col. 15 lines 40-55, col. 22 line 39 to col. 23 line 6).

Guthrie discloses an automated system for storing configuration information for a plurality of pieces of equipment, wherein the automated system instantaneously detects both authorized and unauthorized changes to a physical hardware configuration of a piece of equipment and automatically communicates configuration change information to a centralized database which correlates the changes (Abstract; Fig. 1-2, col. 4 lines 39-55, col. 22 lines 37-43).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to combine the teachings of Guthrie within the method taught collectively by Sims and Bates with the motivation of efficiently and effectively managing configuration changes which is crucial to providing effective and efficient engineering, installation, and maintenance services by having access to current and accurate configuration information (Guthrie; col. 1 lines 10-27, col. 2 lines 15-25).

(B) As per claim 4, Guthrie discloses storing hardware configuration information for a piece of equipment (Abstract; Fig. 1-2, col. 4 lines 39-55, col. 22 lines 37-43).

In addition, insofar as Applicant recites "chosen from the set including...", it is irrelevant whether or not Sims, Bates, and Guthrie disclose every single statement recited in the claim.

(C) As per claim 5, Sims discloses storing a serial number and property number, name, and manufacturer for a device in an inventory database (col. 15 lines 40-55).

(D) Claims 15-17 repeat the same limitations as claims 3-5, and are therefore rejected for the same reasons given for those claims, and incorporated herein.

(E) Claim 25 repeats the same limitations as claim 3, and is therefore rejected for the same reasons given for claim 3, and incorporated herein.

7. Claims 8-12, and 18-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sims et al. (5,434,775) in view of Bates (6,057,779) and Guthrie et al. (5,289,372).

(A) As per claims 8-9, Sims discloses a method for tracking the locations of a plurality of deices using a network of communication links comprising (Abstract):

(a) initially storing a new device at a materials management area (col. 15 lines 40-55) (reads on "receiving a new asset at a central site");

(b) entering information about the new device (e.g., name, manufacturer, serial number, property number, etc.) through a computer interface and providing each of said new devices with a tag that identifies said device with respect to other said devices, wherein the tag comprises a tag address to identify the particular device (Fig. 8-9, col. 5

line 55 to col. 6 line 23, col. 15 lines 40-55, col. 22 lines 45-50, col. 23 lines 4-12) (reads on " assigning a unique identifier to each said asset");

(c) storing information that relates each one of the plurality of devices to a determined location with respect to the communication links, such as those associated with materials management area and data management computer, in a database (Fig. 1, col. 22 lines 38-44, col. 24 lines 12-15) (reads on "recording the location of said asset with respect to said central site in a database");

(d) when moving a device, detecting an event such as a disconnection of a tag from a link and reporting and entering the event, i.e., the removal of the device from the communication link in it's current location, into the database (Fig. 7-10, col. 9 line 35 to col. 10 line 53) (reads on "on movement of a said asset, recording exit of the asset from the current location"); and

(e) detecting an event such as a connection of a tag to a link and reporting and entering the event, i.e., the addition of the device to the communication link in it's current location, into the database (Fig. 7-10, col. 9 line 35 to col. 10 line 53).

Sims fails to expressly disclose recording the intended destination site in said database and verifying entry of the asset at the destination site, being the new current location, in said database.

Bates discloses storing in memory a desired geographical location (reads on "recording the intended destination site") and comparing the stored geographical location to a respective determined geographical location to determine whether cargo (reads on "asset") falls within the desired geographical location, wherein the respective

determined geographical location is stored in memory (Fig. 7-8, col. 1 lines 35-46, col. 1 line 65 to col. 2 line 7, col. 2 lines 19-40, col. 4 lines 3-63, col. 5 lines 43-55). The teachings of a database are disclosed by Sims, and are discussed above.

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to combine the features of Bates within the method of Sims with the motivation of reducing the risk of theft by preventing unauthorized access to cargo through a system of verifying the location of the cargo (Bates; col. 1 lines 14-32, col. 1 liens 35-46) and in order to rapidly determine where devices are stored, as well as the number of devices that are available for use, to efficiently manage the inventory of devices (Sims; col. 1 lines 10-21).

Sims and Bates fail to expressly disclose for each asset, recording configuration information relevant to that asset on said database and upon each reconfiguration of an asset at the central site, said configuration information is updated in said database. However, Sims discloses determining the condition of each of device identified by each tag on the device based on detecting the device, wherein the conditions include ready for use, in need of cleaning, and in need of repair, and performing said cleaning and repair in a storeroom area or materials management area (reads on "at central site") (col. 5 lines 10-28, col. 9 line 35 to col. 10 line 41, col. 15 lines 40-55, col. 22 line 39 to col. 23 line 6).

Guthrie discloses an automated system for storing configuration information for a plurality of pieces of equipment, wherein the automated system instantaneously detects both authorized and unauthorized changes to a physical hardware configuration of a

piece of equipment and automatically communicates configuration change information to a centralized database which correlates the changes (Abstract; Fig. 1-2, col. 4 lines 39-55, col. 22 lines 37-43).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to combine the teachings of Guthrie within the method taught collectively by Sims and Bates with the motivation of efficiently and effectively managing configuration changes which is crucial to providing effective and efficient engineering, installation, and maintenance services by having access to current and accurate configuration information (Guthrie; col. 1 lines 10-27, col. 2 lines 15-25).

(B) As per claim 10, Guthrie discloses storing hardware configuration information for a piece of equipment (Abstract; Fig. 1-2, col. 4 lines 39-55, col. 22 lines 37-43).

In addition, insofar as Applicant recites "chosen from the set including...", it is irrelevant whether or not Sims, Bates, and Guthrie disclose every single statement recited in the claim.

(C) As per claim 11, Sims discloses storing a serial number and property number, name, and manufacturer for a device in an inventory database (col. 15 lines 40-55).

(D) As per claim 12, Sims discloses equipping a device with an electronic tag that stores data which includes an address (reads on "unique identifier") stored in a memory of each tag that identifies the device with which the tag is associated (col. 1 line 50 to

col. 2 line 16, col. 5 line 56 to col. 6 line 23, col. 15 lines 40-55, col. 22 lines 45-50, col. 23 lines 1-13).

(E) System claims 18-23 repeat the subject matter of method claims 8-12, respectively, as a set of apparatus elements rather than as a series of steps. As the underlying processes of claims 8-12 have been shown to be fully disclosed by the collective teachings of Sims and Bates in the above rejections of claims 8-12, it is readily apparent that the system disclosed collectively by Sims and Bates includes the apparatus to perform these functions. As such, these limitations are rejected for the same reasons given above for method claims 8-12, and incorporated herein.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure. The cited but not applied prior art teaches inventory management system using transponders associated with specific products (4,636,950), system and methods for controlled asset disposition (5,424,944), apparatus and method for monitoring a plurality of coded articles and for identifying the location of selected articles (5,455,409), system and method for catalog maintenance and utilization (5,848,421), method and system for identifying, organizing... detailed inspection activities for specific items (5,856,931), automated system and method for matching an item of business property to a recipient (5,878,416), system and method for managing data for an equipment calibration laboratory (5,918,191), RFID tagging system for

network assets (5,949,335), network asset survey tool for gathering data about node equipment (6,220,768), asset tracking within and across enterprise boundaries (6,237,051), RFID integrated in electronic assets (6,249,227), industrial plant asset management system (6,421,571), method and system for communicating between supplier and customer devices (6,578,013), integrated computerized materials management system (6,640,246), and a system for communicating with electronic equipment (6,650,622).

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carolyn Bleck whose telephone number is (703) 305-3981. The Examiner can normally be reached on Monday-Thursday, 8:00am – 5:30pm, and from 8:30am – 5:00pm on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached at (703) 305-9588.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703) 306-1113.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

10. **Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks
Washington, D.C. 20231

Or faxed to:

(703) 872-9306 or (703) 872-9326 [Official communications]

(703) 872-9327 [After Final communications labeled "Box AF"]

(703) 746-8374 [Informal/ Draft communications, labeled "PROPOSED" or "DRAFT"]

Hand-delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7th Floor (Receptionist).

CB
May 26, 2004

Alexander Kalinowski
AU 3626
Primary Examiner